The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RANDAL LEE BERTMAN, DAVID FREDERICK CHAMPION
and PETER JAMES BRITTENHAM

_____

Appeal No. 2005-1823
Application 09/143,967

_____

ON BRIEF

_____

Before JERRY SMITH, DIXON and SAADAT, <u>Administrative Patent
Judges</u>.

JERRY SMITH, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on the appeal under 35 U.S.C. § 134

from the examiner's rejection of claims 38, 39, 50, 51, 62, 63

and 73-79. Pending claims 45, 46, 57, 58, 69 and 70 have been

indicated by the examiner to contain allowable subject matter.

The disclosed invention pertains to a mobile client computer which has form filling capabilities based on a predictive widget. The predictive widget uses a combination of recency and frequency of data entries previously entered by the user in filling out entries on a form. The predictive widget automatically enters default entries into a data field without any requirement for user entry.

Representative claim 38 is reproduced as follows:

38. A mobile client computer comprising:

a housing sized to be held and manipulated by the hand of a user;

a processor mounted within the housing for processing digital data memory mounted within the housing for storing digital data and coupled to the processor; a display mounted in the housing and coupled to the processor and the memory for displaying information derived from digital data processed by the processor;

an input digitizer mounted in the housing and overlaying the display, the digitizer being coupled to the processor for input of digital data by a user; and

a control program stored in the memory and accessible by the processor for directing the processing of digital data by the processor;

the control program and the processor cooperating, when the control program is executing on the processor, in

a)   displaying a form defining data fields; and

b)   exercising a predicative widget to supply a data entry for a defined data field;

wherein the control program and the processor cooperate, when the control program is executing on the processor, in exercising the predicative widget to supply a predictive default entry for the defined data field, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field.

The examiner relies on the following references:

Capps	5,666,502	Sep. 09, 1997
Miller	5,805,911	Sep. 08, 1998
		(filed Feb. 01, 1995)
Hoffberg et al. (Hoffberg)	5,901,246	May 04, 1999
		(filed June 06, 1995)

Claims 38, 39, 50, 51, 62, 63 and 73-79 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Capps in view of Hoffberg with respect to claims 38, 39, 50, 51, 62 and 63, and Miller is added to this combination with respect to claims 73-79.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

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modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this

decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of claims 38, 39, 50, 51, 62 and 63 based on Capps and Hoffberg. The examiner cites Capps as teaching a computer that displays forms having defined data fields which are to be filled in and that uses a predictive widget to display default entries for selection by the user. The examiner notes that Capps does not teach that the defined data field is filled with the predictive data entry. The examiner cites Hoffberg as teaching the automatic implementation of a default entry from a predicted list of options. The examiner finds that it would have been obvious to the artisan to combine the Hoffberg implementation of a default entry to the Capps entry form so that the form can be automatically filled in with the most likely option [answer, pages 3-4].

Appellants argue that 1) the examiner has not provided an adequate motivation for combining the teachings of Capps and Hoffberg; 2) the combination of Capps with Hoffberg would change the principle of operation of the Capps device so that it would not perform satisfactorily; 3) the examiner has not presented a reasonable expectation of success when combining Capps with

Hoffberg; and 4) with respect to claim 38, neither Capps nor Hoffberg teaches exercising the predictive widget to supply a predictive default entry for the defined data field, wherein the defined data field is filled with the predictive default entry prior to a user entering a character in the defined data field [brief, pages 5-12].

The examiner responds that the artisan would have been motivated to replace the list of default entries in Capps with the automatic default entry of Hoffberg in order to increase the data entry speed of Capps. The examiner also responds that the proposed modification does not require that the Capps device become a VCR or a medical device so that there is no change to the operation of the Capps device. The examiner disputes the argument that there is no reasonable expectation of success. Finally, the examiner responds that Hoffberg teaches a predictive widget to present a most probable choice to the user which is automatically entered into the blank data field prior to the user entering any character in the data field as recited in claim 38 [answer, pages 7-11].

Appellants respond that the cited passages of Hoffberg do not teach presenting the most probable choice to a user for a defined data field where the defined data field is filled with the most probable choice prior to a user entering a character in the defined data field. Appellants also respond that the examiner has not provided any objective evidence in support of the proposed modification. Appellants also argue that Hoffberg is not reasonably pertinent to the problem Capps was concerned with and that the combination changes the principle of operation of the Capps device [reply brief, pages 2-6].

We will sustain the examiner's rejection of claims 38, 50 and 62 which appellants have indicated will stand or fall together as a single group [brief, page 5]. Hoffberg teaches an input interface for a device that anticipates or predicts the intent of the user so that a default input can be entered. Hoffberg indicates that his invention improves productivity by decreasing the time it takes to communicate a desired action to the computerized device [column 26, lines 28-34]. Hoffberg is similar to Capps in that Hoffberg teaches displaying the most frequently used choices as the default setting [column 51, lines 62-63]. Finally, Hoffberg teaches a smart screen interface in which a predictive widget automatically enters a default entry

without input by the user [column 75, lines 40-44]. Thus, even
though there is no explicit suggestion in Hoffberg to replace the
list of entries as taught by Capps with an automatic default
entry, we agree with the examiner that Hoffberg provides
motivation for the modification by explicitly teaching that it
speeds up the entry of commands to the computer.

Appellants' argument that the proposed modification
alters the operation of Capps is not persuasive. The only
feature of Hoffberg to be added to the device of Capps is the
automatic default entry from the predictive list of inputs.
Capps would otherwise retain all of its operational features. We
are also not persuaded by appellants' argument that Hoffberg and
Capps are unrelated and cannot be combined. Hoffberg teaches an
improvement for the entry of information into a device. The
person skilled in the art of computers would have been aware of
related arts where similar data entry is required. Thus, the
artisan would have been familiar with automatic predictive data
entry as taught by Hoffberg, and the artisan would have been
motivated to improve the data entry in Capps for the speed
advantage as taught by Hoffberg.

Appellants' argument that there is no evidence that the proposed modification would be successful is not convincing. The electronic arts are very predictable. We see no reason why the simple modification of Capps proposed by the examiner would not be successful. The modification relates to data entry only and suggests nothing complicated. With respect to the defined data field, Capps teaches a device which permits entry of data into defined data fields. The proposed modification simply allows the defined data fields of Capps to be automatically filled with default entries as taught by Hoffberg.

With respect to separately argued claims 39, 51 and 63, which stand or fall together [brief, page 5], appellants make the same arguments considered above, and in addition, they argue that neither Capps nor Hoffberg teaches the "wherein" clause of claim 39.

We will sustain the examiner's rejection of claims 39, 51 and 63 for the reasons discussed above. We note again that Hoffberg teaches that it uses predictive intelligence to fill in the blanks which can be rejected by the user if they are inaccurate [column 75, lines 40-44; column 81, lines 14-17]. We note that claim 39 does not recite "the most probable choice" as argued by appellants, but instead, claim 39 merely recites

selecting a predictive default entry. The entry made in Hoffberg to "fill in the blank" is clearly a predictive default entry. As noted above, the defined data field comes from the teachings of Capps and not from Hoffberg. Finally, the default entry in Hoffberg clearly takes place prior to an entry by the user because Hoffberg teaches that the default entry anticipates the intent of the user. None of appellants' arguments persuades us that the rejection is in error.

We now consider the rejection of claims 73-79 based on Capps, Hoffberg and Miller. These claims stand or fall together as a single group [brief, page 5]. The examiner's findings with respect to Capps and Hoffberg have been discussed above. In the rejection, the examiner acknowledges that Capps and Hoffberg fail to teach circuitry operable for predictive filling of an entry in the form after the user enters one or more characters in the entry field. The examiner cites Miller as teaching this feature. The examiner finds that it would have been obvious to the artisan to combine Miller's teaching of predicting the user desirable option after the user has input characters in a data field [answer, pages 4-5].

Appellants argue that the examiner's motivation for combining the applied prior art references is insufficient to support the rejection and is not supported by any objective evidence. Appellants also argue that none of the applied references teaches circuitry operable for predicting a default user's choice in an entry in the form prior to the user entry of a character in the entry [brief, pages 13-17].

The examiner responds that the motivation for combining the references is that Miller teaches an improvement over item entry by automatically completing the entry once one or more characters have been entered by the user. The examiner notes that this form of automatic entry would enhance the data input taught by Capps [answer, pages 12-13].

Appellants respond that Miller is not reasonably pertinent to the particular problem Capps was concerned with, and therefore, the artisan would not reasonably be expected to look at Miller for a solution to the problem facing Capps. Appellants also respond that the examiner has not provided any motivation for modifying Capps to predict a default user's choice in an entry in a form prior to the user entering a character in the entry as recited in claim 73 [reply brief, pages 6-8].

We will sustain the examiner's rejection of claims 73-79.
The motivation to modify Capps with Miller is the same as the
motivation to modify Capps with Hoffberg as discussed above. In
other words, Miller teaches that default text completion is a
feature of a user interface which offers simple shortcuts for
entering very common input [column 1, lines 32-34]. Thus, the
artisan would have been motivated to fill partially started
entries in Capps to provide a shortcut as taught by Miller. Data
entry shortcuts are clearly related to the problem taught by
Capps. Appellants' argument regarding default data entry prior
to the user making any entry was discussed above and decided to
appellants. Thus, none of appellants' arguments convince us that
the rejection was made in error.

In summary, we have sustained each of the examiner's
rejections of the claims on appeal. Therefore, the decision of
the examiner rejecting claims 38, 39, 50, 51, 62, 63 and 73-79 is
affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

<u>AFFIRMED</u>

JERRY SMITH   )
Administrative Patent Judge   )
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JOSEPH L. DIXON   )   BOARD OF PATENT
Administrative Patent Judge   )   APPEALS AND
)   INTERFERENCES
)
MAHSHID D. SAADAT   )
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